

Please amend the application as follows:

**IN THE SPECIFICATION**

Page 1, line 5, delete "continuation" and replace with --continuation-in-part--.

**REMARKS**

This is a full and timely response to the final Office Action of March 9, 1999, and Advisory Action of April 23, 1999. Reexamination, reconsideration, and allowance of the application and all presently pending claims are respectfully requested.

Upon entry of this Third Response, claims 1-21 and 23-49 remain pending in this application. The specification has been amended to correctly claim priority to various other earlier filed U.S. patent applications as a continuation-in-part application rather than as a continuation application. This amendment corrects for a recently discovered clerical error and, therefore, places the present application in a better condition for appeal or publication. Accordingly, entry of the foregoing amendment is respectfully requested pursuant to 37 C.F.R. §1.116. It is believed that the foregoing amendment adds no new matter to the present application.

Furthermore, Exhibits A - F are submitted herewith in response to recent allegations in the Advisory Action that Applicant has not submitted sufficient evidence to establish that the subject matter disclosed in U.S. Patent Nos. 5,648,770 and 5,444,444 (hereinafter referred to as the "770 patent" and the "444 patent" respectively) was derived from Applicant. Applicant submits that these allegations have been raised for the first time in the Advisory Action and that Applicant, therefore, has not been given a previous opportunity to address these allegations. Accordingly,

Applicant asserts that Exhibits A - F are timely filed and respectfully requests that the Examiner consider these Exhibits.

**Response to §102(e) Rejections**

“(T)he fact that an application has named a different inventive entity than a patent does not necessarily make that patent prior art.” *Applied Materials Inc. v. Gemini Research Corp.*, 15 U.S.P.Q.2d 1816, 1818 (Fed. Cir. 1988). “(A)n applicant’s own work, even though publicly disclosed prior to his application, may not be used against him as a reference, absent the existence of a time bar to his application.” *In re DeBaun*, 214 U.S.P.Q. 933, 935 (C.C.P.A. 1982). Therefore, an applicant may overcome a rejection based on a patent “by showing that the patent disclosure is a description of applicant’s own previous work. Such a showing can be made by proving that the patentee was associated with applicant (e.g. worked for the same company) and learned of applicant’s invention from applicant.” M.P.E.P. §2136.05; see, also, *In re Mathews*, 161 U.S.P.Q. 276 (C.C.P.A. 1969).

**Claims 1-14, 27, 28, 31-35, 37-41, 43-47, and 49**

Claims 1-14, 27, 28, 31-35, 37-41, 43-47, and 49 presently stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by the ‘770 patent and, in the alternative, the ‘444 patent. However, Applicant submits that the subject matter disclosed by the ‘770 and ‘444 patents and used by the Patent Office to reject pending claims 1-14, 27, 28, 31-35, 37-41, 43-47, and 49 is the product of Applicant’s own previous work. Therefore, the filing dates of the ‘770 and ‘444 patents are not “before the invention,” as defined by the pending claims of the present application, within

the meaning of 35 U.S.C. §102(e). Consequently, the '770 and '444 patents are not valid prior art references under 35 U.S.C. §102(e), and the rejections to pending claims 1-14, 27, 28, 31-35, 37-41, 43-47, and 49 should be withdrawn.

### Response to §103 Rejections

#### Claims 36, 42, and 48

Claims 36, 42, and 48 presently stand rejected under 35 U.S.C. §103 as purportedly being obvious to the '770 patent, and in the alternative, the '444 patent. However, for the same reasons set forth hereinabove in the arguments for allowance of pending claims 1-14, 27, 28, 31-35, 37-41, 43-47, and 49, Applicant submits that the subject matter disclosed by the '770 and '444 patents and used to reject pending claims 36, 42, and 48 of the present application constitutes Applicant's own prior work. Therefore, the '770 and '444 patents are not valid prior art references, and the rejection to pending claims 36, 42, and 48 should be withdrawn.

### Response to Arguments in Advisory Action

It is apparently asserted in the Advisory Action of April 23, 1999, that the case of *Applied Materials, Inc. v. Gemin Research Corp.* is distinguishable from the present case because "the present application names only one inventor Mr. Martin Kelly Jones, while the US patents in question name only one and distinct inventor Mr. John Ross." However, Applicant respectfully submits that it is not necessary for a prior art reference to have the same inventorship as the present application to remove the prior patent as a prior art reference under 35 U.S.C. §102(e) via a declaration pursuant to 37 C.F.R. §1.132. As set forth in the Second Response filed on April 6,

1999, a prior patent was removed as a prior art reference under 35 U.S.C. §102(e) via a declaration under 37 C.F.R. §1.132 in the case of *In re Mathews* even though the applicant in *Mathews* was not a named inventor of the prior patent. 161 U.S.P.Q. 276 (C.C.P.A. 1969). Consequently, Applicant respectfully asserts that the Advisory Action improperly distinguishes the present case from the law set forth by *Applied Materials*.

It is further alleged in the Advisory Action that the facts of the present case are distinguishable from *In re Mathews* because, unlike the facts in *Mathews*, the Applicant was not a co-worker with Ross, the named inventor of the prior patent. However, Applicant respectfully asserts that it is not necessary to establish that an applicant and a named inventor of a prior patent were “co-workers” to remove the prior patent as reference under 35 U.S.C. §102(e). In this regard, it is only necessary to show that the named inventor of the prior patent derived his knowledge of the relevant subject matter from the applicant. The applicant and prior inventor being co-workers is only one scenario in which this may happen, and *Mathews* should not be interpreted as requiring evidence showing that the applicant was a co-worker of the named inventor of the prior patent. In fact, it is asserted in M.P.E.P. §2136.05 that:

when the unclaimed subject matter of a patent is applicant’s own invention, applicant may overcome a prima facie case based on the patent by showing that the patent disclosure is a description of applicant’s own previous work. Such a showing can be made by proving that the patentee was associated with applicant (*e.g.* worked for the same company) and learned of applicant’s invention from applicant. (Emphasis added).

Therefore, it is recognized by the M.P.E.P. that the applicant being a co-worker of the named inventor is only an *example* of a scenario in which the named inventor may derive subject matter from the applicant. Accordingly, Applicant respectfully asserts that it is not necessary for the

Applicant to submit evidence showing that the Applicant and Ross were co-workers to remove the '770 and '444 patents as prior art references pursuant to *In re Mathews*.

In addition, even though Applicant traverses the foregoing "co-worker" requirement set forth in the Advisory Action, Applicant submits that the "co-worker" requirement is satisfied by the facts of the present case. In this regard, Exhibits A - F submitted herewith show that Applicant and Ross were attempting to form a business together and that Ross was responsible for raising money for the business. Therefore, Applicant submits that he and Ross were, in fact, "co-workers."

Furthermore, it is also alleged in the Advisory Action that:

The mere fact that the declaration filed on February 8, 1999 includes a statement, by applicant, that applicant is a "co-inventor" of the patents to Ross and that applicant invented the subject matter disclosed in the patents to Ross, is not a basis to remove the Ross patents as prior art and withdrawn the rejections. Based on the limited information presented herein, the examiner is not able to make a decision as to withdraw(n) the rejections. Applicant would need a disclaimer from Mr. Ross and/or the assignee of the Ross patents affirming that applicant's statement is true or any other evidence showing such. If Mr. Ross refuses to (cooperate), this issue is out of the examiner's hand and should be resolved between applicant and Mr. John Ross.

Therefore, the Advisory Action apparently alleges that the evidence submitted by the Applicant is insufficient to establish that Ross derived the relevant subject matter from the Applicant. Accordingly, to further support Applicant's position that the Applicant invented the subject matter relied on to reject the pending claims of the present application, Applicant submits Exhibits A - F herewith.

In this regard, the Applicant has asserted in a declaration submitted with the First Response filed on February 2, 1999, that Applicant invented the subject matter relied on to reject the pending claims of the present application and that Applicant disclosed the subject matter to Ross in efforts of obtaining financing for Applicant's invention. It is Applicant's belief that Ross had no

conception of an advance notification system prior to the Applicant's disclosure to Ross. Once Applicant disclosed the advance notification system to Ross, Ross did suggest the use of a card reader system to implement on the vehicles of the advance notification system (see paragraph 4 of the declaration by the Applicant submitted with the First Response), but Ross had no further technical input. After Ross failed to obtain financing, the Applicant and Ross parted company, and Ross later filed patent applications including the subject matter invented by the Applicant and disclosed to Ross.

The Exhibits submitted with the First Response and newly submitted Exhibits A - F tend to show that Applicant's assertions in the declaration submitted with the First Response are truthful and accurate. In this regard, Exhibit B submitted with the First Response shows that a relationship between the Applicant and Ross existed prior to the filing dates of the patents granted to Ross. Furthermore, Exhibit A submitted herewith shows that this relationship was terminated, as claimed by the Applicant in the First Response, once Ross failed to raise sufficient funds. Exhibit A of the First Response shows that Ross at least conceded that the Applicant is an inventor of the advance notification system by signing a non-disclosure agreement that listed Applicant as an "inventor" (see also paragraph 5 of the declaration submitted by Applicant in the First Response). Note that Ross is not listed as an inventor on the non-disclosure agreement. Exhibits B - E submitted herewith show that third parties met with Applicant and Ross and discussed the advance notification system. Each of these third parties believed that Applicant, and not Ross, was the inventor of the product being discussed.

In particular, Mr. Mark Stubbins stated that he and Applicant "met with Mr. Ross for the sole purpose of having him help us raise money ... Mr. Ross's only involvement was his 'finding

capital' for starting a company to exploit the technology. He had no substantive input on the ideas or concepts associated with the advance notification system. The advance notification system was conceived of and its design was well defined in both system implementations, *long before Mr. Ross was involved.*" (Emphasis added). See paragraph 12 of Exhibit B submitted herewith. Furthermore, Mr. Stubbins reviewed a claim of the '770 patent and the '444 patent to Ross and stated that the apparatus described by these claims was invented by Applicant and disclosed to Ross "before Ross thought about or knew anything about this 'apparatus.'" (See paragraphs 17 and 18 of the foregoing Exhibit).

Ms. Gena Payne also reviewed the same claims of the '770 patent and the '444 patent and asserted that the subject matter of the claims was disclosed to her by Applicant and that "Ross made no claim to have invented (the apparatus), in whole or in part." See paragraphs 5 and 6 of Exhibit C submitted herewith. In fact, Ms. Payne stated that "it is beyond amazing that John Ross can actually claim that he is the inventor of any technology surrounding the advance notification field." See paragraph 5 of the foregoing Exhibit. Furthermore, Ms. Payne (as well as Mr. Anthony Hunt) also stated that John Ross admitted to them that the advance notification system was Applicant's idea and that Ross was helping to raise money. (See paragraphs 3 and 4 of Exhibit C submitted herewith and paragraph 12 of Exhibit D submitted herewith).

Furthermore, Mr. Rusty Gordon, once a vice president at GTE, also met with Applicant and Ross regarding the advance notification system. Mr. Gordon stated that he understood Applicant to be the inventor and Ross to be a financial advisor at the meeting. (See paragraph 8 of Exhibit E submitted herewith). Mr. Gordon also reviewed the same claims reviewed by Mr. Stubbins and

Ms. Payne and stated that he discussed all of the elements of the claims "before Kelly (Applicant) met John Ross." See paragraphs 9 and 10 of the foregoing Exhibit.

Consequently, Applicant respectfully asserts that Exhibits A - B, the declaration submitted with the First Response, and Exhibits A - F submitted herewith sufficiently prove that Applicant, not Ross, invented the subject matter which was disclosed by the Ross patents and relied upon to reject the pending claims of the present application and that Ross derived this subject matter from Applicant. Accordingly, for the reasons set forth hereinbefore, the '770 and '444 patents are not proper prior art references under 35 U.S.C. §102(e).

### **CONCLUSION**

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted ,

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